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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/012,269 02/01/93 KWON

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HM12/0227  
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EXAMINER

BRANNOCK, M

ART UNIT

PAPER NUMBER

1646

43

DATE MAILED:

02/27/01

02/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Advisory Action

Application No.  
08/012,269

Applicant(s)

Kwon, BS

Examiner

Michael Brannock, Ph.D.

Group Art Unit

1646



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 4 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Feb 6, 2001 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
  - ☒ will not be entered because:
    - ☒ they raise new issues that would require further consideration and/or search. (See note below).
    - ☐ they raise the issue of new matter. (See note below).
    - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
    - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attachment to Advisory Action

- ☒ Applicant's response has overcome the following rejection(s):

See attachment to Advisory Action

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

See attachment to Advisory Action

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: None

Claims objected to: 2 and 3

Claims rejected: 1, 22, and 28-30

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

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**Attachment to Advisory Action**

1. The period for reply is extended to run 4 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 must be timely filed to avoid abandonment of this application.

2. The amendment filed 2/6/01 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

The proposed amendment raises new issues that would require further consideration and/or search: amended claims 1 and 22 raise new issues under 35 U.S.C. 112, second paragraph (see below), amended claim 22 introduces new limitations to the claim that would require a new search, i.e. fragments corresponding to positions 661-855 and 128-1557 of SEQ ID NO: 1.

**New Issues:**

3. The proposed amendments to claim 1 would render the claim indefinite because the claim now requires that the cDNA sequence comprise SEQ ID NO: 2, SEQ ID NO: 2 being an amino acid sequence. The word "which" in the phrase "which encodes for murine protein 4-1BB"

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indicates that the phrase is parenthetical, consequently, the phrase "comprising SEQ ID NO: 2" is indicated to apply to the cDNA and not to the murine protein 4-1BB.

4. The proposed amendments to claim 22 would render the claim indefinite for the following reasons:

a) the word "corresponds" renders the claims indefinite because it is a relative word and it is impossible to know what does and what does not correspond to the recited positions.

b) it is unclear what the phrase "or the complement thereof" refers to.

5. The following claim language is suggested:

A purified and isolated DNA molecule comprising a nucleic acid selected from the group consisting of:

a) a nucleic acid sequence encoding SEQ ID NO: 2,

b) a nucleic acid sequence consisting of positions 661-855 of SEQ ID NO: 1,

c) a nucleic acid sequence consisting of positions 1281-1557 of SEQ ID NO: 1, and

d) the complement of (a), (b) or (c).

6. The rejection of claims 1 and 22 in Papers 20 (page 4) and 17 (page 10) under 35 USC 112, first paragraph, for lacking an enabling disclosure of derivatives of SEQ ID NO: 1 or for DNAs useful as probes, is maintained, however Applicant's proposed arguments and

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amendments in the response of 2/6/01, requiring the polynucleotides to comprise SEQ ID NO: 1 or the positions 661-855 or 1281-1557 of SEQ ID NO: 1, would have been found persuasive had the amendments been entered.

7. The rejection of claims 28-30 under 35 U.S.C. 112, second paragraph, as set forth in item seven of the previous office Action, Paper 39, is maintained, however Applicant's proposed arguments in the response of 2/6/01 would have been found persuasive had the amendments been entered.

### ***Conclusion***

8. Claims 1, 22, 28-30 are not allowable.

9. Claims 2 and 3 are objected to.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Fridays from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB



February 23, 2001

*David Rome*  
*Primary Examiner*